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IN THE

Supreme Court of the United States

OCTOBER TERM, 1947

No. 308

ALVIN H. COHEN,

Respondent,

against

LOUIS BUNIN,

Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE DIVISION OF THE SUPREME COURT, FIRST JUDICIAL DEPARTMENT, OF THE STATE OF NEW YORK, AND BRIEF IN SUPPORT THEREOF

SAMUEL J. COHEN,
Attorney for Petitioner.

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PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE DIVISION OF THE SUPREME COURT, FIRST JUDICIAL DEPARTMENT, OF THE STATE OF NEW YORK

To the Honorable Fred L. Vinson, Chief Justice, and the Associate Justices of the Supreme Court of the United States:

The petition of Louis Bunin respectfully shows unto this Honorable Court:

I. Summary Statement of Issues Involved

A. The Nature of the Action

This case arises upon the respondent's claim to joint inventorship of an invention patented by petitioner on April 8, 1941. United States Patent Office Letters Patent No. 2237751 were granted to petitioner, Louis Bunin (R. 19).

The patented invention was of an image or puppet, particularly designed for use in making of motion pictures with stop-motion technique (R. 435). Respondent claimed in an action commenced in 1942 in the Supreme Court of the State of New York that he and petitioner had jointly carried on research and experiments leading to the creation and use of animated puppets, forming the basis of the patented invention. It is also claimed by the respondent that he disclosed, during this period of claimed joint work, various ideas in confidence respecting the creation of such puppets or images (R. 5). Respondent asserted, as well, that the parties made an agreement to own in equal shares any device or invention resulting from their mutual efforts (R. 12).

Petitioner denied that the respondent contributed to the creation of the invented article or that there was any agreement leading to joint ownership; he also denied that there was any confidential or fiduciary relationship between the parties.

B. The Issues Before the Trial Court and Its Findings

Extensive proof was taken and many issues were presented upon trial in the State Court. Upon this petition, however, only certain facts may be deemed relevant and those facts are taken from the findings of the Trial Court. These findings were not disturbed on appeal, and form the basis of the judgment entered in the State Court. As such they may be regarded as facts not in dispute.

The respondent's position was based upon a three-fold claim; (1) a contractual agreement to share ownership; (2) a fiduciary relationship arising out of the confidential disclosure of ideas leading to the creation of the invented article and (3) the claim of co-inventorship. The issue which remained for determination before the Trial Court upon its own findings was ultimately reduced to the question as to whether or not the State Court had jurisdiction to make a determination that respondent had an interest

in the patented invention upon the sole basis of co-inventorship.

The Trial Court found:

1. "No. 15. That no contract either oral or written was ever entered into between the defendant and the plaintiff" (R. 25).

2. The existence of a fiduciary or confidential relationship was also negated by the Court, it having found as a fact: "No. 51. That the plaintiff never requested the defendant to keep secret any information, ideas or suggestions which he offered to defendant in relation to animated puppets" (R. 32).

   "No. 52. That the defendant never agreed to keep secret any information, ideas or suggestions offered to him by the plaintiff in relation to animated puppets" (R. 32).

Such findings having been made, the Trial Court stated the issue as follows:

> "The question which remains, therefore, is whether the Court can give relief to the plaintiff on the basis of his being a joint inventor and not on the basis of contract. It is at this point that we meet the argument of the defendant that the Court, particularly the State Court may not compel an assignment of a patent upon a finding of facts which would render the patent invalid (Kennedy v. Hazelton, 128 U. S. 667), it being the law that a patent taken out by only one of two joint inventors is void. According to the defendant, the plaintiff should be relegated to some procedure in the Federal Court to have the patent declared invalid" (R. 496).

Petitioner took the position that in the absence of fiduciary or contractual relationship between the parties leading to joint ownership, the State Court had no jurisdiction to adjudicate a claim based upon alleged co-inventorship (R. 494).

C. The Judgment

The judgment of the Trial Court entered in the New York County Clerk's office on May 5, 1944, decreed:

1. That U. S. Letters Patent No. 2237751 issued to petitioner Louis Bunin be decreed to be the joint invention of petitioner and respondent.

2. That either party be entitled to make use of invention covered by Letters Patent No. 2237751 and to license others so to do without accounting to the other party.

3. That petitioner execute an assignment of an undivided one-half interest to respondent in U. S. Letters Patent No. 2237751 (R. 37-39).

D. Appeals

Upon appeal to the Appellate Division of the Supreme Court of the State of New York, the First Department, the judgment below was unanimously affirmed without opinion and judgment of affirmance was entered on October 4, 1946. Petitioner, upon such appeal to the Appellate Division, urged that the plaintiff's (respondent's) complaint should have been dismissed for lack of jurisdiction of the subject matter, upon the ground that the State Court was without jurisdiction to determine the naked question of inventorship of a patented invention. The issue was presented to the Appellate Court that U. S. Judicial Code, U. S. C. A. Title 28, Section 371, expressly provides that jurisdiction as to all cases arising under patent laws and copyright laws of the United States shall be vested in the Courts of the United States exclusive of the Courts of the several States. There was also presented to the Appellate Court petitioner's contention that the judgment contravenes Article 1, Section 8 of the United States Constitution, which gives Congress power to deal with matters of patent law. The State Court having been

without jurisdiction of the subject matter, it was also urged before the Appellate Court that the judgment contravenes the Fourteenth Amendment to the United States Constitution, and that the proceedings constituted a denial of due process.

The judgment having been unanimously affirmed, without opinion, petitioner made application to the Appellate Division of the Supreme Court of the State of New York for leave to appeal to the Court of Appeals of the State of New York. Such application set forth once more the grounds previously referred to. Such application was denied October 4, 1946, without opinion.

Thereupon, the sole remedy remaining to the petitioner was to apply to the Court of Appeals for leave to appeal to that State Court of last resort. Such application was made and once again there was presented petitioner's claim that the State Court lacked jurisdiction, and that the judgment violated Article I, Section 8 of the United States Constitution and the Fourteenth Amendment of the United States Constitution. The Court of Appeals on January 16, 1947, denied the application for leave to appeal to it, without opinion, and its order was made and entered as the order of the Supreme Court of the State of New York on January 22, 1947.

Petitioner moved for reargument of his motion addressed to the Court of Appeals for leave to appeal to that Court. The same issues above mentioned arising under the Federal Statutes and United States Constitution were laid before the Court and it was also pointed out that decision of the Court of Appeals in denying leave to appeal necessarily involved consideration of Federal and constitutional questions. The Court of Appeals denied the motion for reargument on May 29, 1947. On June 17, 1947, the order of the Court of Appeals was made the order of the Supreme Court of the State of New York.

II. Jurisdiction of This Court

The judgment in question is a final judgment rendered after trial of the action. It has been affirmed by the Appellate Division of the Supreme Court of the State of New York. That Court and the Court of Appeals of the State of New York, the highest Court of the State, have refused permission to review the judgment in the Court of Appeals. The petitioner is without further remedy or relief in the State Courts.

Petitioner has urged upon the New York State Courts his contention that the said final judgment violated his rights under the United States Constitution, in contravention of Article I, Section 8, and the Fourteenth Amendment. These contentions have been overruled and the absolute judgment of the Trial Court has not been modified in any respect.

A substantial Federal question is thus presented, and this Court clearly has jurisdiction to issue a writ of certiorari to the Appellate Division of the Supreme Court, First Judicial Department, of the State of New York, pursuant to Section 237-b of the Judicial Code of the United States (28 U. S. C., Sec. 334-b).

III. The Questions Presented

Stated in concise form, the questions presented are as follows:

(1) May a State Court, in the absence of a contractual or fiduciary relationship, and in the absence of any other claim independent of the Patent Laws of the United States, render judgment determining inventorship of an invention patented under the Patent Laws of the United States?

(2) Does the State Court, under such circumstances, have jurisdiction to make a determination of co-inventorship and decree assignment of property interests in an invention patented by one of the parties?

In discussion of the reasons for the allowance of the Writ of Certiorari sought by the petitioner, immediately following, we shall consider in detail the foregoing questions.

IV. Reasons for the Allowance of the Writ

The judgment issued by the New York State Supreme Court was upon an issue as to which it lacked jurisdiction of the subject matter. The Court having found, by its own statement, that no contractual or fiduciary relationship existed, the sole issue which remained was that of inventorship of a patented invention under the United States Patent Laws. Such issue was not one which arose incidentally to the determination of rights existing independently of the Patent Laws. The action having resolved itself into one arising solely under the Patent Laws of the United States, the State Court was without jurisdiction.

Becher v. *Contoure Laboratories, Inc.*, 279 U. S. 388.

The final judgment expressly determined the inventorship of a patented invention. It was not a judgment whose purpose was merely to protect common law rights in an undisclosed invention. The decree contained the following basic provision:

> "ORDERED, ADJUDGED AND DECREED that United States Letters Patent Number 2237751 are hereby determined to be the joint invention of the plaintiff Alvin H. Cohen, and the defendant Louis Bunin, and it is further hereby * * *" (R. 37-38).

Article I, Section 8 of the United States Constitution, gives Congress power to secure "for a limited time, to Authors and Inventors, the exclusive right to their respective Writings and Discoveries". Congress having exercised its power by enactment of the Patent Laws, and the grant of jurisdiction to the Federal Courts respecting all cases arising under the Patent Laws, the State Courts are without power to nullify patents issued by the United States Commissioner of Patents, or otherwise to review the acts of such Commissioner. The judgment, therefore, contravenes this provision of the United States Constitution.

There can be no doubt that patents are property. *Paper Bag Case*, 210 U. S. 405. This judgment deprives the defendant of the exclusive use of his patent property. Since the State Court is without jurisdiction, such deprivation contravenes the provision of the Fourteenth Amendment to the United States Constitution forbidding any State to deprive any person of his property, "without due process of law".

U. S. C. A., Title 35, Section 69, specifies as a ground of invalidity that the patentee "was not the original and first inventor or discoverer of any material and substantial part of the thing patented". Adequate remedy to the respondent existed in the Federal Courts. Appropriate action to have the patent declared invalid was available to him (U. S. C. A., Title 28, Sec. 400).

> *Mitchell and Weber, Inc.* v. *Williams Bridge Mills, Inc., et al.* (Southern District of New York), 14 Fed. Supp. 954.

Jurisdiction to determine questions arising under the Patent Laws having been reserved to the Federal Courts by action of Congress, which flows from the basic provisions of the Constitution, nothing remains jurisdictionally for the State Courts. A contrary holding would, of course, give rise to great confusion and misapplication of the Patent Laws.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the Appellate Division of the Supreme Court, First Judicial Department of the State of New York, demanding that Court to certify and send to this Court for review and determination on a day certain to be therein named a full and complete transcript of the record and all proceedings in the case, entitled on its docket, *Alvin H. Cohen* v. *Louis Bunin*, and that the order and judgment of the said Appellate Division of the Supreme Court, First Judicial Department, may be reversed, and that your petitioner may have such other and further relief as may be just and proper.

LOUIS BUNIN,
Petitioner.

by SAMUEL J. COHEN,
Attorney for Petitioner.

IN THE

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. Opinion of Courts Below

The Supreme Court of the State of New York made findings of fact and conclusions of law (R. 17-36) and rendered an opinion in writing (R. 492-497). The Appellate Division of the Supreme Court of the State of New York, First Judicial Department, wrote no opinion, either upon its unanimous affirmance of the judgment below, or upon its denial of petitioner's motion in that Court for reargument or for leave to appeal to the Court of Appeals. The Court of Appeals of the State of New York wrote no opinion either upon the application for leave to appeal to that Court or upon petitioner's motion for reargument of the motion for leave to appeal to the Court of Appeals.

II. Jurisdiction

The statutory provision believed to sustain the jurisdiction of this Court to review judgment of the Appellate Division of the Supreme Court of the State of New York is Section 237-b of the Judicial Code of the United States (Title 28, U. S. C., Sec. 344-b).

Date of Entry of Judgment to Be Reviewed

The judgment of the New York State Supreme Court was entered on May 5, 1944. This judgment was unanimously affirmed without opinion by the Appellate Division of the Supreme Court, First Judicial Department of the State of New York June 3, 1946. The Appellate Division, also without opinion, denied petitioner's motion for reargument or leave to appeal to the Court of Appeals October 4, 1946. The Court of Appeals denied, without opinion, petitioner's motion for leave to appeal to the Court of Appeals on January 16, 1947. Petitioner made a motion to reargue this motion for leave to appeal.

The order of the Court of Appeals of the State of New York denying petitioner's motion for reargument of his motion for leave to appeal to the Court of Appeals of the State of New York was made May 29, 1947. The petition is timely within the requirements of Section 243 of the Judicial Code of the United States (Title 28, Section 350).

III. Statement of the Case

A summary statement of the facts has already been made in the preceding petition for a writ of certiorari, and for purposes of brevity is hereby adopted and made a part of this brief.

IV. Specification of Errors to Be Urged

Error is urged in that the courts of the State of New York, have, upon the sole basis of alleged co-inventorship, granted judgment affecting petitioner's property rights in an invention patented by the United States Patent Office. Such judgment did not arise as an incident to the determination of common law rights or as collateral to other issues. The basic question as to which the Trial Court made the determination related solely to respondent's claim of proprietary interest in petitioner's patented invention, upon the theory of co-inventorship. No fiduciary relationship or contractual relationship was found to have existed between the parties (R. 25, 32). No claim founded upon any basis independent of the Patent Laws was established, as the opinion of the Trial Court plainly states (R. 496). The judgment was affirmed by the Appellate Division and review thereof was refused by the Court of Appeals. These holdings necessarily constituted invasion of the petitioner's property rights in his patented invention. The State Courts had no jurisdiction to render such judgment and Article I, Section 8 and the Fourteenth Amendment to the United States Constitution have been violated.

V. Summary of Argument

A. The respondent's complaint should have been dismissed for lack of jurisdiction of the subject matter.

(1) There was directly presented to the State Courts, respondent's claim to interest in the patented invention based solely upon his theory of co-inventorship.

(2) The State Courts have no jurisdiction to determine rights which arise solely and primarily under the Patent Laws of the United States.

B. The judgment contravenes Article I, Section 8 and the Fourteenth Amendment of the United States Constitution.

(1) The judgment contravenes Article I, Section 8, of the United States Constitution.

(2) The judgment contravenes the Fourteenth Amendment of the United States Constitution.

VI. Argument

A. The respondent's complaint should have been dismissed for lack of jurisdiction of the subject matter.

(1) Respondent's complaint herein purported to set forth an alleged cause of action sounding in contract. On its face, therefore, assuming a sufficient cause of action in contract to have been alleged, the complaint furnished a ground for State Court jurisdiction. When this basis for jurisdiction was definitely eliminated, however, by the Trial Court's specific finding that no contract, oral or written, existed (fols. 73, 1485-1487), it necessarily followed that the Court had no further jurisdiction of the action. Accordingly the complaint should have been dismissed. The defendant duly moved for dismissal upon this ground at the close of the plaintiff's case (fols. 670-671). After reserving decision, the Trial Court eventually denied the motion and proceeded to consider the sole issue of inventorship under the patent laws, a matter exclusively Federal. (In passing, it is worthy of note that, even had the question of jurisdiction not been adequately raised by defendant, the power of the Court to consider the issue would not have been enlarged, for jurisdiction of the subject matter may not be acquired by consent. *Dudley* v. *Mayhew*, 3 N. Y. 9.)

That the Trial Court rendered judgment on the sole issue of inventorship of a patented invention is clearly shown by the Trial Court's opinion:

"The question which remains therefore is whether the Court can give relief to the plaintiff on the basis of his being a joint inventor and not on the basis of contract" (R. 496).

Not a single reported authority has been found establishing the power of a State Court to determine the naked issue of the inventorship of a patented invention. It is well established that State Courts may consider and determine "questions" arising under the patent laws incidental to causes of action based upon common law rights, but it is equally well established that "cases" arising under the patent laws are beyond the purview of the State Courts and that jurisdiction of such matters is vested solely in the United States Commissioner of Patents and in the Federal Courts.

Becher v. *Contoure Laboratories, Inc.*, 279 U. S. 388;
Dudley v. *Mayhew*, 3 N. Y. 9;
New Era Electric Range Co. v. *Serrell*, 252 N. Y. 107;
Ebsary Gypsum Co. v. *Ruby*, 256 N. Y. 406.

The distinction between "questions" and "cases" is easily apprehended. A cause of action based upon a common law right, antecedent to and independent of the patent laws, may involve, incidentally, the consideration of one or more issues based upon the patent laws in order that a determination may be made of the main issue. In such instances, the State Courts are not ousted of jurisdiction. On the other hand, where the cause of action is founded on the patent laws, jurisdiction is exclusively Federal.

The principles above stated are based upon the Constitution of the United States and upon U. S. Judicial Code, U. S. C. A. Title 28, Sec. 371, which provides that as to "all cases arising under the patent-right, or copyright laws of the United States" the jurisdiction vested in the courts of the United States "shall be exclusive of the courts of

the several states". We do not understand the rule to be that where a plaintiff fails to establish any right to relief under the State law, the State Court can give him relief under the patent law merely because the plaintiff had made a claim under the State law which he failed to sustain. If this were true, a plaintiff could bring any patent "case" in the State Court by the device of entangling it with mere unfounded allegations of a right to relief under the State law.

Typical of actions involving "questions" are those where claim is made that common law property rights in a patented invention have been misappropriated (*New Era Electric Range Co.* v. *Serrell,* 252 N. Y. 107) and those where claim is made that a relationship of trust has been violated by the misappropriation of confidential disclosures (*Becher* v. *Contoure Laboratories, Inc.,* 279 U. S. 388). In such cases the State Courts undertake to protect common law property rights. Questions under the patent laws may arise incidentally and in such cases may be considered, but in those cases the State Courts exercise a jurisdiction which rests entirely upon the existence of a valid cause of action independent of the patent laws.

The first type of case is illustrated by *New Era Electric Range Co.* v. *Serrell,* 252 N. Y. 107, wherein the plaintiff alleged that an application for Letters Patent was assigned by the defendant inventor to the plaintiff's predecessor in interest, and that later the defendant filed a new application for Letters Patent upon the identical device in breach of his assignment to the plaintiff's predecessor. It was urged by the Court that because of the possibility that complicated patent questions, such as determination of the identity of the subject matter of both patent applications, might have to be considered by the State Court, jurisdiction was lacking. The Court of Appeals properly disposed of this contention as follows:

> "The Courts of this State are not asked to revise any action of the Commissioner of Patents. They are

asked to pass upon the plaintiff's alleged title to a device or invention based solely upon an assignment, and questions of title to an invention or device based upon assignment or upon general equitable principles are within the jurisdiction of the courts of the state, even when the invention is covered by a patent" (252 N. Y. 107, 112-113).

The second type of case is illustrated by *Becher* v. *Contoure Laboratories, Inc.*, 279 U. S. 388, where it was found that a machinist working for the inventor and entrusted with the inventor's secrets, pursuant to an agreement to keep that information secret and confidential, broke the agreement and applied for a patent covering the device in question in his own name. Mr. Justice Holmes summarized the facts as follows:

"The judgment was based on the facts alleged and found, that Oppenheimer, having made the invention in question, employed Becher as a machinist to construct the invented machine and improvements made by Oppenheimer from time to time, and that Becher agreed to keep secret and confidential the information thus obtained, and not to use it for the benefit of himself or of anyone other than Oppenheimer. It was found further, that while engaged in making instruments for Oppenheimer and after having learned from him all the facts, Becher, without the knowledge of the plaintiffs, and in violation of his agreement and of the confidential relationship existing, applied for and obtained a patent, of which Oppenheimer knew nothing until after it had been issued, and while Becher was still making for him the Oppenheimer Machine" (279 U. S. 388, 389-390).

Upon these facts, Mr. Justice Holmes concluded:

"It is plain that such suit had for its cause of action the breach of a contract or wrongful disregard of confidential relationships, both matters independent of the Patent Laws, and that the subject matter of Oppenheimer's claim was an undisclosed invention which did not need a patent to prevent it from disclosure by breach of trust" (279 U. S. 388, 391).

Under these circumstances, the United States Supreme Court held that the State Court did not lack jurisdiction by reason of the fact that its findings logically if not legally resulted in the conclusion that the patent, assignment of which to the plaintiff was prayed for, was a fraud and a nullity.

These cases are based upon contract and trust relationship, either express or implied, matters utterly independent of the patent laws. The New York State Courts in the case at bar, however, overlooked the fundamental distinction between this case and the foregoing cases. In this case, there was no breach of contract, either express or implied. The Trial Court so found. It also found specifically:

> "51. That the plaintiff never requested the defendant to keep secret any information, ideas, or suggestions which he offered to the defendant in relation to animated puppets.
>
> 52. That the defendant never agreed to keep secret any information or ideas or suggestions offered to him by the plaintiff in relation to animated puppets" (R. 32).

There was, therefore, left in this case nothing except the naked question of inventorship, and the State Court's jurisdiction must stand or fall on that alone.

(2) No breach of contract or of trust having been involved, this case was precisely the same as any case wherein a person other than the patentee claims that he is the original inventor and seeks an adjudication whereby he, rather than the patentee, will become the owner of the patent. Such relief can be obtained only through the Federal Courts or the United States Commissioner of Patents.

> *Becher* v. *Contoure Laboratories Inc.*, 279 U. S. 388;
> *Dudley* v. *Mayhew*, 3 N. Y. 9;
> *New Era Electric Range Co.* v. *Serrell*, 252 N. Y. 107;
> *Ebsary Gypsum Co.* v. *Ruby*, 256 N. Y. 406;
> *Griffith* v. *Dodgson*, 103 App. Div. 542 (New York).

In *New Era Electric Range Co.* v. *Serrell,* 252 N. Y. 107, the Court of Appeals stated that it was not "asked to revise any action of the Commissioner of Patents." In the case at bar, the respondent was asking precisely that, and once the question of contract had been eliminated from the case, his claim was simply that he should be adjudicated a co-patentee, notwithstanding the fact that the Commissioner of Patents had found the defendant to be the inventor and had issued the patent to him solely. The plaintiff's claim was not one which arose independent of the patent laws; it was a claim which could not exist but for the patent laws, for no inventor has a right to the status of patentee on the ground of invention except by virtue of the United States Patent Laws. In *Griffith* v. *Dodgson,* 103 App. Div. 542, 545, it was stated:

> "So far as this Court is asked to restrain these defendants from prosecuting any claim that they had before the Patent Office at Washington, it would seem that the Commissioner of Patents has exclusive jurisdiction to determine whether the plaintiff or the defendants is entitled to a patent which the plaintiff alleges he invented. The Supreme Court of the State of New York has no jurisdiction to determine the priority of the invention for which a patent is asked. If the plaintiff's contentions are correct, we must assume that the Commissioner of Patents will so decide, and that the plaintiff will obtain his letters patent. The Commissioner of Patents would certainly refuse to recognize an injunction granted by this Court, if the Court attempted to interfere with him in the performance of the duties which are vested in him by the constitution and laws of the United States; and he having full jurisdiction to determine the very question that the plaintiff wishes to have determined in this action, namely, who was the inventor of the improvement or device for which a patent is asked, this Court has certainly no authority to determine that question."

It must be clearly borne in mind that the respondent in the case at bar did not prove the invasion of any common law rights on the part of the defendant, and his complaint

was devoid of any prayer for relief other than an adjudication that he was a joint patentee (see complaint; R. 13-20).

A claim of joint inventorship certainly can not be deemed to give the State Court the jurisdiction which it would lack in a claim involving sole inventorship.

The Trial Court attempted to draw support for its position from *Becher* v. *Contoure Laboratories,* 279 U. S. 388 (R. 497). This was a superficial and incorrect conclusion. Careful analysis demonstrates that the *Becher* case is sound authority for petitioner's claim. As we have pointed out, the basis for State Court jurisdiction in that case was a cause of action founded upon contract, independent of the patent laws. The United States Supreme Court certainly did not decide that a State Court would have jurisdiction in a case involving merely rival claims of inventorship divorced from any common law claim based upon contract and trust relationship. No such question was presented to the Supreme Court, and no authority has been found which supports the jurisdiction of the State Court in the case at bar.

The Trial Court was apparently influenced toward an assumption of jurisdiction by the belief that "there is no procedure in the Federal Court by which a joint inventor can have a patent taken out by his co-inventor declared invalid. (Mowery v. Whitney, 14 Wall. 434, 439; Briggs v. United Shoe Machinery Co., 239 U. S. 48, 50)" (R. 1488).

Here again the Trial Court misapprehended the patent law, and as a result cited decisions which have no bearing. *Mowery* v. *Whitney* was decided in 1871, which was before the present statute; in fact, the decision cites the Act of 1836. *Briggs* v. *United Shoe Machinery Co.* was "to enforce payment of royalties" (239 U. S. at 49), and nothing in the decision is applicable to the question of the remedy available, in the Federal Court, to the present plaintiff.

U. S. C. A. Title 35, Sec. 69, provides as a ground of invalidity that the patentee "was not the original and first inventor or discoverer of any material and substantial part of the thing patented". Thus, if plaintiff be a joint inventor, he has a plain and adequate remedy in the Federal Court. Certainly an actual controversy exists and hence plaintiff is, and was, in a position to bring an action under the Declaratory Judgment Act (U. S. C. A. Title 28, Sec. 400) to have the patent declared invalid. In *Mitchell and Weber, Inc.* v. *Williams Bridge Mills, Inc. et al.* (Southern District of New York), 14 Fed. Supp. 954, Judge Patterson said:

> "A suit to have a patent declared void is one arising under the patent laws and is within the jurisdiction of the District Court, now that the Declaratory Judgment Act has furnished the necessary procedural machinery. Zenie Bros. v. Miskend, 10 F. Supp. 779 (D. C. N. Y.); Automotive Equipment v. Trico Products Corporation, 11 F. Supp. 292 (D. C. N. Y.); Lionel Corporation v. De Filippis, 11 F. Supp. 712 (D. C. N. Y.)"

In any event, the possible lack of a convenient or potent Federal remedy can hardly be said to generate State Court jurisdiction otherwise non-existent. Patent rights are artificial creations of Federal law, unknown to common law, and those seeking advantages based solely upon the patent laws are entitled to no remedies other than those provided by Congress. In *Dudley* v. *Mayhew*, 3 N. Y. 9, 17, the Court of Appeals stated:

> "The exclusive right of the inventor to make and vend his newly-discovered implement is wholly statutory. The Constitution of the United States has vested the power of creating and moulding it in the general government. Whether concurrent power to legislate on this subject was reserved to the States, it is not necessary to inquire, as if it was, it has never been exercised in this State. But it has been fully and satisfactorily exercised by the National Legislature, and the existing rights of inventors depend wholly upon its enactments. The Act of 1836 gives to patentees all

the encouragement and protection which they can reasonably desire. Competent tribunals are designated in the act to enforce its provisions, and in terms which may well be construed to indicate an intention to confine judicial action in such cases to them. Some of the designated remedies too are peculiar, and not such as are furnished in the same form by the common law, and can be enforced in the manner indicated only by courts whose proceedings can be controlled by congressional legislation."

B. The judgment contravenes Article I and Amendment XIV of the United States Constitution.

1) The judgment contravenes Article I, Section 8, of the United States Consitution.

Article I, Section 8, of the United States Constitution gives Congress power to secure "for a limited Time to Authors and Inventors the exclusive right to their respective Writings and Discoveries". Congress having exercised its power by enacting the Patent Laws, the States are without power to grant patents to inventors.

The Constitution speaks of the "exclusive Right" of inventors which Congress, pursuant to such provision, has protected by enactment of the Patent Laws, vesting sole jurisdiction over the subject matter in the Federal Courts. It becomes immediately apparent that any assumption of jurisdiction by State Courts makes uniform administration of the Patent Laws impossible and destroys the constitutional scheme. We cannot have duplicate Commissioners of Patents, State and Federal; we cannot have inventorship of patented inventions determined by the Commissioner of Patents and the Federal Courts and at the same time have inventorship subject to independent review by the State Courts without wrecking the purpose of the Constitution which was to vest in Congress the power to secure to inventors "the exclusive Right to their * * * Discoveries".

The patent which the judgment gives to the respondent is not the patent of another to which the respondent is entitled by contract; it is a patent given to the respondent solely because of his alleged joint inventorship of a new device. This is clear from the opinion of the Trial Court, which says:

> "The question which remains therefore is whether the court can give relief to the plaintiff on the basis of his being a joint inventor and not on the basis of contract" (R. 496).

By virtue of Article I, Section 8, of the United States Constitution, and the patent laws enacted pursuant thereto, the sole power to grant patents to all inventors resides in the Federal Government. No power is reserved to the States to grant patents to such inventors as are joint inventors; and the judgment therefore contravenes the United States Constitution.

2) The judgment contravenes the Fourteenth Amendment of the United States Constitution.

There can be no doubt that patents are property. *Paper Bag Case,* 210 U. S. 405.

In the case at bar the judgment of the Trial Court deprives the petitioner of the exclusive use of his patent property. It thereby contravenes the provision of the Fourteenth Amendment of the United States Constitution which forbids any State to deprive any person of his property "without due process of law".

We believe it to be self-evident that the subjection of the petitioner to the judgment of a court concerning subject matter over which that court does not have jurisdiction constitutes a denial of "due process".

CONCLUSION

The writ of certiorari requested by the petitioner should be granted, and the judgment of the Appellate Division of the Supreme Court, First Judicial Department, of the State of New York, should be reviewed by this Court and the judgment should be reversed.

Respectfully submitted,

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